

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-31, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-5, 7, 8, 10-15, 17, 18, 20-25, 27, 28, 30, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0135860 ("Dureau") in view of US Patent № 7,065,778 ("Lu"). Claims 6, 9, 16, 19, 26, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dureau in view of Lu, further in view of U.S. Patent Application Publication No. 2003/0066084 ("Kaars"). The Applicant respectfully traverses these rejections at least based on the following remarks.

### **REJECTION UNDER 35 U.S.C. § 103**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning

with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

**I. The Proposed Combination of Dureau and Lu Does Not Render Claims 1-5, 7, 8, 10-15, 17, 18, 20-25, 27, 28, 30, and 31 Unpatentable**

The Applicant now turns to the rejection of claims 1-5, 7, 8, 10-15, 17, 18, 20-25, 27, 28, 30, and 31 as being unpatentable over Dureau in view of Lu. The Applicant notes that the proposed combination of Dureau and Lu forms the basis for all of the pending rejections.

**A. Rejection of Independent Claims 1, 11, and 21**

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Dureau and Lu does not disclose or suggest at least the limitation of "converting within said first home, said received media file from said first format to a second format compatible for one or both of presentation and/or playback on a television screen within a second home in a second geographic location," as recited by the Applicant in independent claim 1.

The Final Office Action states the following:

The claimed "converting within said first home, said received media file from said first format to a second format compatible for one or both of presentation and/or playback on a television screen within a second home in a second geographic location" is met in part by Dureau that discloses the converting of received data by a proxy receiver, 12, from a first format to a second format and the use of any number of receiving devices, 30A-N, including a television for the display of the transcoded data at the same geographic location (Abstract; Figs. 1,2&4; paragraphs [0012J, [0028J, & [0035-0037]). The Dureau reference is silent with respect to the "presentation and/or playback on a television screen within a second home in a second geographic location". However, in the same field of endeavor, the Lu reference teaches the use of a personalized video recorder (PVR) in transmitting recorded media from a first geographic location to a second geographic location for viewing on display device 212 (Abstract; Figs. 2-4; col.2, lines 25-28; col.6, lines 54-58; col. 7, lines 47-53; col.9, lines -20-26; col. 10, lines 10-15, 26-38; col. 11, line 66 to col. 12, line 2; col. 13, lines 47-51; col. 14, line 65 to col. 15, line 2).

See the Final Office Action at pages 3-4. The Examiner concedes that the Dureau reference is silent with respect to the "presentation and/or playback on a television screen within a second home in a second geographic location". However, the Applicant

points out that the relevant claim limitation here is **“converting within said first home ... from said first format to a second format compatible for ... presentation and/or playback ... within a second home in a second geographic location.”** In other words, the important functionality is “converting” from one format to another format that is used for presentation/playback at a second geographic location. The “presentation/playback” language is related to, and further clarifies, the relevant functionality of “converting”, namely the converting is done “for presentation/playback.” The Applicant emphasizes that **Dureau is not only silent with respect to the “presentation and/or playback on a television screen within a second home in a second geographic location”, but Dureau is also silent and also does not disclose or suggest “converting within said first home ... from said first format to a second format compatible for ... presentation and/or playback ... within a second home in a second geographic location,”** as recited in Applicant's claim 1.

The Examiner relies on Lu to teach “transmitting recorded media from a first geographic location to a second geographic location.” The Applicant respectfully disagrees as this only partially describes Dureau's deficiencies. As explained above, Dureau is deficient in not disclosing or suggesting “converting within said first home ... from said first format to a second format compatible for ... presentation and/or playback ... within a second home in a second geographic location.” Lu, including all the citations relied on by the Examiner, does not overcome the above stated deficiencies of Dureau.

Therefore, the combination of Dureau and Lu does not disclose or suggest at least the limitation of "converting within said first home, said received media file from said first format to a second format compatible for one or both of presentation and/or playback on a television screen within a second home in a second geographic location," as recited by the Applicant in independent claim 1.

Accordingly, the proposed combination of Dureau and Lu does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-5, 7, 8, 10, 12-15, 17, 18, 20, 22-25, 27, 28, 30, and 31**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Dureau in view of Lu has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-5, 7, 8, 10, 12-15, 17, 18, 20, 22-25, 27, 28, 30, and 31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-5, 7, 8, 10, 12-15, 17, 18, 20, 22-25, 27, 28, 30, and 31.

**II. The Proposed Combination of Dureau, Lu and Kaars Does Not Render Claims 6, 9, 16, 19, 26, and 29 Unpatentable**

The Applicant now turns to the rejection of claims 6, 9, 16, 19, 26, and 29 as being unpatentable over Dureau in view of Lu and Kaars.

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Dureau in view of Lu has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Kaars) does not overcome the deficiencies of Dureau and Lu, claims 6, 9, 16, 19, 26, and 29 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 6, 9, 16, 19, 26, and 29.

**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 30-SEP-2008

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